



Paper No. 5

HEWLETT-PACKARD COMPANY
Intellectual Property
Administration
P.O. Box 272400
Fort Collins CO 80527-2400

COPY MAILED**JUL 17 2002****OFFICE OF PETITIONS**

In re Application of
Camble, et al.
Application No. 10/034,888
Filed: December 28, 2001
Attorney Docket No. 30014515-1

DECISION ON PETITION

This is a decision on the "Petition to the Commissioner" filed April 11, 2002, requesting that the above-identified application retain a filing date of December 28, 2001, and that inadvertently omitted Fig. 4 be entered.

The application was filed on December 28, 2001. On January 13, 2002, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application" stating that the application had been accorded a filing date; however, Figure 4 described in the specification appeared to have been omitted.

In response, applicants filed the previously omitted Fig. 4. Applicants further asserted that pursuant to MPEP §601.01(g) applicants are willing to accept the application as deposited with the USPTO and retain the filing date of December 28, 2001. However, applicants submit this petition and the accompanying Fig. 4 to clarify paragraphs 14 and 23 of the specification wherein a Fig. 4 is listed and described. Petitioner further cites to MPEP §608.02, which states that "A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains: (A) at least one process claim including the term "process" or "method" in its introductory phrase;" and notes that claims 7 and 13 which reference Fig. 4 are both method claims. Furthermore, petitioner cites 37 CFR §§1.181(d) and (b), contending that: Claims 7 and 13 are self-enabling. The specification fully enables these claims at least in the description provided in paragraph 23. Fig. 4 is not submitted in an attempt to "overcome any sufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure," or to "supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim." The scope of these claims is self-evident and/or redefined by the enabling disclosure of at least paragraph 23. Fig. 4 is not required under 37 CFR 1.181(a) as it is not "necessary for the understanding of the subject matter sought to be patented" and is presented for inclusion in the application to provide clarification of paragraphs 14, part of the "Brief Description of the Drawing" and paragraph 23, wherein Fig. 4 is described in detail.

Petitioner's arguments are not well taken. Petitioner acknowledges that Fig. 4 was not among the papers filed on December 28, 2001. Since the sheet of drawings containing Fig. 4

was not filed on December 28, 2001, the application cannot be accorded a filing date of December 28, 2001, with the drawing sheet containing Figure 4 as a part of the original disclosure of the application.

Pursuant to §608.02, and as stated in MPEP §601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). Thus, such applications filed without drawings will be accorded a filing date without drawings as a part of the original application disclosure. Furthermore, MPEP §608.02 sets forth that where drawings are not necessary, the examiner may require drawings where the subject matter admits of illustration. However, a drawing is considered necessary under the first sentence of 35 U.S.C. 113 in all applications where the drawing is referred to in the specification and one or more figures have been omitted. Thus, such applications filed with omitted drawings will be accorded a filing date without the omitted drawings as a part of the original application disclosure. Additionally, the applicant will be mailed a "Notice of Omitted Items."

The Office properly treated the instant application pursuant to MPEP §601.01(g), as an application filed without all of the drawing figures referred to in the specification. Applicants were notified that Fig. 4 described in the specification appeared to have been omitted and given the option of (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue, or (2) promptly submit the omitted drawing in a Nonprovisional application and accept the date of submission as the application filing date. Applicants do not dispute that Fig. 4 was omitted. Rather, applicants state that they are willing to accept the application as deposited with the USPTO and retain the filing date of December 28, 2001, but argue, in effect, for entry of the omitted figure on petition. This is not an option.

Accordingly, the petition is **DISMISSED**.

In view of the above, the application will be processed with a filing date of December 28, 2001, using the three (3) sheets of drawings filed on that date.

An amendment canceling the references to Fig. 4 in the specification should be filed prior to the first Office action in order to avoid further delays in the examination of the application.

The drawing containing Figures 4 filed on April 11, 2002, will not be entered on petition.

The application is being returned to Initial Patent Examination Division:

- for further processing with a filing date of December 28, 2001, and
- for indication on the file wrapper label that three (3) sheets of drawings were present on filing.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries related to this decision should be directed to Petitions Attorney Nancy Johnson at 703-305-0309.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy